

REMARKS

This paper responds to the Office Action dated April 9, 2003.

The Applicant requests a one-month extension of time to respond to the Office Action up to and including August 12, 2003. A check in the amount of 110.00 to affect the extension for a large entity is attached hereto. In the event that the Commissioner finds that additional funds are necessary to affect the extension, or in the event that a credit is in order, he is authorized to appropriately debit or credit our Deposit Account No. 22-0261.

In the Office Action dated April 9, 2003 the Examiner has withdrawn the Office Action and rejection dated November 5, 2002, has rejected claims 3-7 and has made the action final. The Examiner has also indicated that the rejected claims 3-7 constitute all the remaining pending claims. We understand that the Examiner's indication that claims 3-7 constitute all the remaining pending claims is a typographical error because it is inconsistent with the Examiner's discussion and apparent rejection of Applicant's additional pending claims 8 through 10. These claims were submitted in the Applicant's Amendment dated August 13, 2002 and remain pending.

The Applicant understands that the Examiner's earlier communication in the Office Action dated November 5, 2002 that Claims 8 and 10 would be allowable if rewritten in independent form including all the limitations of the base claim and any

intervening claims was an oversight. Further, the Applicant's Amendment dated January 2, 2003 has not been entered in view of the new grounds of rejection. In summary, claims 3-10 (all the pending claims) stand rejected and none of the claims presently are considered to contain allowable subject matter.

In view of the Examiner's withdrawal of previously allowed claims, it is respectfully requested that the indication that the April 9, 2003 Action is final be withdrawn. In this regard, the Applicant has not had an opportunity to amend these claims in view of the Examiner's present position. Further, the Applicant has not been provided with a meaningful manner to address the new grounds of rejection. It is submitted that the entry of a final rejection in these circumstances is inappropriate and contrary to the Examining rules. See MPEP Rule 705.04. Withdrawal of the final rejection is respectfully requested.

Claims 3, 6 and 7 have been rejected under 35 U.S.C. §103 over Okada '604 patent ("The Okada '604 patent") in view of Okada '785 (the Okada '785 patent") or Manship et al. ("Manship").

Claims 4-5, 8 and 10 have been rejected under 35 U.S.C. §103 over the Okada '785 patent or Okada '785 in view of Manship.

Claim 9 has been rejected under section 103 over Okada '785 or Okada '785 in view of Manship.

In response to the rejection, the Applicant has canceled claims 3-7 and 9 and added new claims 11-16.

Claim 8 has been amended to incorporated~~ed~~ the limitation previously set forth in claim 3 and the Applicant has further clarified the limitations so that (1) the lateral dimension of the specified symbol must be greater than the remainder of the symbols on the shift and display means (as supported in the specification by the wheel structure in a preferred embodiment and hereafter identified as a "wheel" herein) and (2) each shift and display means has a plurality of separate and distinct window observation areas, each area accommodating one symbol, wherein the symbols consecutively rotate through the window observation areas.

It is submitted that Okada '785 discloses a game machine that includes a stop function that can be activated at a desired time but does not disclose the claimed features wherein (1) the display means or wheels contain a number of symbols having a larger lateral dimension than the remainder of the symbols as required by claims 8 and (2) neighboring adjacent analogous symbols on the display means or wheel have a larger lateral dimension than other symbols as required by claim 8. It is submitted that the claimed feature wherein certain symbols on the wheel or display means have a lateral dimension that is greater than the lateral dimension of the remainder of symbols on the wheel display (as previously set forth in claim 3), is not disclosed nor is it suggested by the

prior art.

As discussed herein, this feature enables a player to better anticipate when the stop buttons should be activated to try and obtain a winning result. By providing a predetermined number of symbols having a lateral dimension that is appreciably greater than the remainder of the symbols on the wheel, as the symbols pass the user, those with a larger lateral dimension can be easier recognized by a player.

It is difficult for unskilled game players to operate the stop button at the right time when playing conventional game machines such as that disclosed by the Okada '785 game. As a result, while experienced game players will enthusiastically play such games, inexperienced game players tend to refrain from playing. See Page 2 line 17- 26 of the specification. In order to address this problem, the inventor has provided a game machine having specified symbols that are relatively large in comparison with other symbols that facilitate the identification of the symbols as they pass through the observation area. In particular, these symbols have a larger lateral dimensions and, in another embodiment, two related symbols are located adjacent to one another (in a vertical array on the wheel).

While the symbol having a larger lateral dimension was a first advancement taught by the Applicant, because the specified symbol mark targeted by a game player may be changed in response to the game conditions of the machine, further modifications to the target display were also considered. In this regard, for example, when a game machine is

operated under a bonus condition, it may be necessary to stop the display that is representative of this bonus prize winning state,(e.g. 7-7-7) on the prize line by the observation push.

It was further considered that providing symbols with a larger vertical dimension would make it easier for an inexperienced player to complete the observation push procedure. However, an increase in the size in a vertical dimension would involve spanning more than one observation window. See page 3 line 29 to 36 of the specification. The Applicant solved this problem by providing related symbols adjacent to one another on the display wheels.

An alternative solution may have been to increase the respective display or wheel size. This would make it easier for a player to see the symbols, and would allow for a larger number of symbols on the wheel. However, increasing the wheel circumference presents other problems. For example, increasing the wheel size would result in a game machine which would not be accommodated in conventional pachinko parlors. Likewise if some of the symbols on a conventional wheel were increased in size, the number of potential winning combinations would be higher and thereby decrease the potential payout.

The Okada '785 Patent does not teach or suggest making a game machine with a predetermined number of symbols with a width approximately equal to the width of the observation window. Further, the Okada '785 patent does not recognize the problem

solved by the Applicant and therefore does not propose any solution to the problem that unskilled players have when they are attempting to operate the stop button to stop the symbols in the observation window at the effective winning lines. Okada does not address any of the problems by the inventor: (1) Large symbols in the lateral direction tend to be watched and recognized by players as being visually interfered with one another, thereby resulting in loss of the aleatory effect stemming from the large sizes of specified symbol marks; (2) Large symbols in the vertical direction may extend across two lines of the observation window; (3) Increasing both lateral and vertical size requires enlargement of game machine making it difficult to accommodate the machines in conventional spaces.

The Examiner's contention that the selection of semi-circular symbols is an obvious design choice is a hindsight conclusion. The design of the semi-circular symbols adjacent to one another, performs a distinct function. The selection and positioning of the semi-circular shape was the result of significant research and development efforts in search of a solution to the aforementioned problems. Neither the problem nor the solution was appreciated by the prior art. See In re Schaffer, 108 USPQ 326 (CCPA 1956) (references which never recognized the applicant's problem cannot have suggested its solution; references were improperly combined since there is no suggestion in either of them that they can be combined to produce applicant's result). *See also, In re Horton*, 121 USPQ 218 (CCPA 1959) (In determining unobviousness of device, it is proper to consider

conception of new and useful improvement along with actual means achieving the improvement; although structure may be a simple expedient when novel concept is realized, structure may not be obvious to skilled worker in art where prior art failed to suggest problem or conceive idea for its elimination.)

Moreover, when patentability turns on the question of obviousness, the search for and analysis of the prior art must also include evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. See, e.g., McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) ("the central question is whether there is reason to combine [the] references," a question of fact drawing on the Graham factors).

Courts have held that "[T]he factual inquiry whether to combine references must be thorough and searching." Id. It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. See, e.g., Brown & Williamson Tobacco Corp. v. Philip Morris Inc., 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) ("a showing of a suggestion, teaching, or motivation to combine the prior art references is an 'essential component of an obviousness holding'" (quoting C.R. Bard, Inc., v. M3 Systems, Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998))); In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle

but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."); In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant); In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) ("teachings of references can be combined only if there is some suggestion or incentive to do so.") (emphasis in original) (quoting ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)).

The need for specificity pervades this authority. See, e.g., In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed");

(¹ In summary, the shapes and relative differentiation between sizes of the specified symbol marks and ordinary symbol marks makes it easier for the player to perform the observation push step.¹ It is submitted that the prior art does not disclose or teach or suggest providing such symbols on game machines having a stop feature that enables the player to stop the rotation of a wheels by activation of a stop button. More specifically, the prior art does not teach or disclose providing a certain class of symbols with a lateral

dimension larger than the remainder of the symbols to enable a player to more easily distinguish the respective symbols as they move⁶ through the observation window in games having a stop feature.

It is submitted that the symbols disclosed by Manship and the Okada patents depict symbols having lateral dimensions that are approximately the same. Further, Manship and Dietz et al. disclose rotating wheels (or simulated rotating wheels) having a single display window in a "three by one" matrix. Because the respective symbols are only visible through a single display window as they rotate, it is significantly more difficult for a player to recognize symbols as they rotate through the display region in those devices. In contrast, in applicant's device the symbols consecutively rotate through three adjacent observation windows in a "three by three" arrangement. This characteristic makes it easier for the player to time the activation of the stop button. Further, while it may appear that the bar symbols of Dietz's II device may have a larger lateral dimension than the other symbols, the remainder of the symbols are not disclosed by the patent so whether the bar is larger than other symbols cannot be determined. Moreover, and more importantly, neither Dietz II nor Manship discloses the claimed stop feature and the applicant's invention is directed to games having such a stop feature.

A further feature of the invention as required in claim 8 relates to the cooperation of adjacent semicircular symbols, both of which have a lateral dimension greater than the

remainder of the symbols on the wheel. As discussed above, by aligning two semi-circular symbols adjacent to one another on a consecutive display or rotatable display wheel (see claim 11), the combination of the symbols itself appears to be a single symbol and is more easily recognized by a player as it rotates in and out of the observation regions.

At page 3 of the Office Action, the Examiner asserts that the selection of a ½ watermelon symbol is analogous to the claimed feature. The Applicant respectfully requests reconsideration of the rejection in view of these remarks. While it was known to use watermelon symbols that are inherently a semicircular symbol, the prior art did not disclose aligning two watermelon symbols (or semicircular symbols) adjacent to one another wherein one of the symbols was inverted to result in a cohesive single symbol. Further, as claimed herein, this cohesive symbol has a larger lateral dimension than the remainder of the symbols on the wheel, thereby making the recognition of the cohesive symbol easier to the player.

Claim 8 has been rewritten in independent form to include all the limitations of its base claim 3. Note that in the rewriting of claim 8 in independent form the redundant and second recitation of “said shift and display means for shifting and displaying various kinds of symbol marks” found in both claim 3 and claim 8 has been eliminated. Amended Claim 8 also adds the additional limitations as discussed above.

It is submitted that new claims 11-13 are dependent upon claim 8 and these claims should be found allowable for the same reasons that their base claim is allowable. New claim 11 is directed to features recited in claim 6, now canceled, new claim 12 is directed to the features recited in claim 7, now canceled, and new claim 13 is directed to the limitations recited in claim 9, now canceled.

Claim 10 is directed to the gaming device as recited therein and more particularly wherein a player can select play according to a plurality of different operating states dependent on the player's preference. Claim 10 is directed to the limitations previously recited in claims 4 and 5. This claim includes game functions that incorporate the stop feature when the game state is in the small prize winning game state and a game function that inactivates the stop feature when the game is in the big prize winning state. Like some prior art devices, the operating states also allow for multiple manners of winning including three lateral arrangements and two diagonal arrangements. It is submitted that the claimed feature on a gaming device that enables the prospective player to select operating states that include stop function games is not disclosed nor suggested by the prior art. This limitation is recited as "said winning state determinative means is operative to determine a plurality of small prize winning states....thereby making it possible for small size winning states to be requested in one game unless said big prize winning state or medium prize winning state is requested." It is submitted that this

*arguing
limitations
not recited
in the
claims*

claimed function is simply absent from and in no way suggested by the prior art.

New claims 14-16 are dependent upon claim 10 and these claims should be found allowable for the same reasons that claim 10 is allowable. New claim 14 is directed to features recited in claim 6, now canceled, new claim 15 is directed to the features recited in claim 7, now canceled, and new claim 16 is directed to the limitations previously recited in claim 9, now canceled.

In view of the foregoing, it is respectfully submitted that this application is now in condition for allowance and favorable reconsideration thereof is earnestly solicited.

Respectfully submitted,

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